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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
JACKY JOACHIM, ET AL. : EXAMINER: GRAY, J. M.
SERIAL NO: 09/786,113 :
FILED: JUNE 4, 2001 : GROUP ART UNIT: 1774
FOR: METHOD FOR MAKING A :
FIBROUS INSULATING PRODUCT,
SIZING STUFF AND COMPOSITION

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated December 1, 2005 (Answer).

Applicants continue to maintain all the arguments made in the Appeal Brief. The following replies to "(10) Response to Arguments", beginning at the bottom of page 8 of the Answer.

Applicants note that the Appeal Brief discusses, as a preface to arguing the particular grounds of rejection, the background of the present invention and the comparative data in the specification. This preface was intended to, and did, apply to all the grounds of rejection. However, the only discussion of the comparative data in the Answer is that it is irrelevant with regard to Ground (A), which ground is an anticipation rejection, and that with regard to the other grounds of rejection, which are all under 35 U.S.C. § 103(a), the data is, in effect, not probative of non-obviousness because "the compositions in the prior art all contain a latex

as well” (Answer at 9). The Examiner then finds that “[a]ccordingly, there is no evidence on this record of superior or unexpected properties of the instant composition over those compositions taught in the prior art containing a latex. In addition, there is no evidence on this record of superior or unexpected properties of the claimed critical method steps over the prior art” (Answer at 9).

As will be detailed below, whether or not a particular prior art reference relied on by the Examiner discloses the presence of a latex does not end the matter. The prior art, taken as a whole, neither discloses nor suggests the improved results obtained, as discussed in the Appeal Brief.

Ground (A)

In response to Applicants’ citation of the *Arkley* case as the correct approach to take in anticipation rejections, the Examiner finds that “all of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art” (Answer at 9-10).

In reply, Applicants do not dispute the law embodied by the above-quoted passage, but it does not respond to Applicants’ argument. But the Examiner has identified no particular insulation product in Lindemann et al allegedly meeting the terms of the claims under rejection.

The Examiner erroneously finds that the process steps of Claim 15 can, in effect, be ignored absent a “back-to-back comparison” of Lindemann et al (Answer at 10).

In reply, a comparison with the prior art may be necessary when the evidence suggests that the product claimed and the product of the prior art are at least substantially identical. Such a finding cannot be made in the present case. Indeed, the Examiner has not responded to any of the specific arguments in the Appeal Brief demonstrating that the

structure of the presently-claimed insulation product is different from the glass fiber mat of Lindemann et al.

The Examiner finds the limitation of Claim 15 that the hydrophilic latex comprises *a dispersion or emulsion of homopolymer or copolymer prepared from one or more monomers each having at least one hydrophilic functional group selected from the group consisting of hydroxyl, carboxyl and ester* “clearly embraces” the disclosure by Lindemann et al of polymers at “column 3, lines 3-9 and column 10, lines 61-64” (Answer at 10-11).

In reply, the description at column 3, lines 3-9 is a description of prior art emulsion polymers that have been used to treat non-wovens and is not a description of a hydrophilic latex for application to a just formed mineral wool which has been, or is simultaneously, treated with a size comprising a thermosetting resin. The description at column 10, lines 61-64 of Lindemann et al is that the polymer emulsions of Lindemann et al’s invention, as binders, can also contain thermosetting resins. But, as explained in the Appeal Brief, a binder must be distinguished from a size.

In addition, present Claim 15 provides that the hydrophilic latex in the insulation product comprises, in the first-recited embodiment, a dispersion or emulsion of a homopolymer or copolymer prepared from one or more monomers **each** having at least one hydrophilic functional group selected from the group consisting of hydroxyl, carboxyl and ester. As noted in the Appeal Brief at page 11, Lindemann et al has no requirement that the monomers contain hydrophilic functional groups. Indeed, Lindemann et al’s preferred polymer combination contains a polyvinylacetate or ethylene-vinylacetate copolymer, and polystyrene (which clearly contains no hydrophilic functional groups) (column 6, line 20ff).

Ground (B)

The Examiner has not substantively responded to any of the particular arguments regarding Kajander in the Appeal Brief. The Examiner simply responds with the rejoinder that “the Examiner has considered the reference as a whole and what the teachings of said reference would reasonably convey to the skilled artisan at the time of the invention thereof” (Answer at 11). The Examiner seems to be saying that Kajander is relied on for a disclosure “that the addition of a hydrophilic latex during sizing is known in the art” (Answer at 11).

In reply, Applicants have no opinion on whether a hydrophilic latex has been used for sizing in specific applications different from that claimed herein, but do not agree that the use of a hydrophilic latex during sizing is accepted as a general proposition in the art. Indeed, Applicants most strenuously disagree that a hydrophilic latex is suggested in the prior art for use as used in the present invention. Kajander simply neither discloses nor suggests the presently-claimed invention with or without the combination of either Lindemann et al or Meng et al, for reasons discussed in the Appeal Brief.

The Examiner finds that Lindemann et al “would have provided a suggestion to substitute the binder taught by [Kajander] with a binder of the type contemplated by [Lindemann et al], and [Meng et al] teaches that thermosetting film formers are a known component in size compositions” (Answer at 12).

In reply, these conclusions by the Examiner have no factual basis, and without the present disclosure as a guide, there is no motivation to combine these references.

While the Examiner cites the *McLaughlin* case for the proposition that a prior art rejection is acceptable if it does not involve hindsight reasoning (Answer at 12), it is clear herein that the Examiner has engaged in just that, i.e., hindsight reasoning.

Ground (C)

The Examiner simply describes how WO '411 was relied on (Answer at 13). But the Examiner does not explain how this reference overcomes the deficiencies in the combination of Kajander, Lindemann et al and Meng et al.

Ground (D)

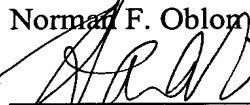
The Examiner simply describes how WO '437 was relied on (Answer at 13). But the Examiner does not explain how this reference overcomes the deficiencies in the combination of Kajander, Lindemann et al and Meng et al.

CONCLUSION

Applicants continue to maintain that all of the rejections should be REVERSED.

Respectfully submitted,

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